

REMARKS

The application has been amended and is believed to be in condition for allowance.

The withdrawal of the rejections in view of Virog et al. (US 4,046,275) is gratefully acknowledged.

Amendments to the Application

Independent claim 13 is amended to sharpen the recitation of a distinguishing feature recited the in the claim. The amendment finds support in the specification and the drawing figures as originally filed (e.g., paragraphs [0034]-[0035] of the published specification; Figures 1-2) and are not believed to introduce new matter.

The claims are further amended to address the Official Action's formal objection and rejections of the claims in view of Section 112, as further detailed below.

The foregoing claim amendments and new claims are directed toward the elected claim Group I drawn to a decorative band.

It is further submitted that, based at least on the foregoing citations to the specification and drawing figures originally filed, the foregoing claim amendments and new claims are not believed to introduce new matter.

Formal Matters - Objections to the Claims

The Official Action objected to claim 15 due to an informality in the preamble.

In response, claim 15 is amended to overcome the Official Action's objection. Withdrawal of the objection to claim 15 is thereby respectfully requested.

Formal Matters - Rejections for Indefiniteness

The Official Action rejected claims 13-15 and 24-26 under 35 USC 112, second paragraph as being indefinite.

In particular, the Official Action objects to the term "substantially" in the claims, stating that the term is subjective and/or depending upon various context, and therefore the claims using this term are considered indefinite.

In response, the term "substantially" is removed from the language of the claims.

The Official Action further objects to the term "configured to".

In response, claims 13, 25 and 26 are amended to remove the phrase "configured to", and claims 13, 25, and 26 are believed to be definite in view of Section 112 as presented.

Particularly, it is respectfully submitted that recitations to perform a function are definite in view of Section 112. "[F]eatures of an apparatus may be recited either by their structures or their functions," *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ2d 1429 1431-32 (Fed. Cir. 1997) (emphasis added). "There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in

and of itself, render a claim improper," MPEP 2173.05(g) quoting *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

"A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step," MPEP 2173.05(g).

Functional recitations are "perfectly acceptable" where the claim "set[s] definite boundaries on the patent protection sought," MPEP 2173.05(g), quoting *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). Claim language like "adapted to" or "being" in relation to a function "serve to precisely define present structural attributes of interrelated component parts of the claimed assembly," MPEP 2173.05(g), quoting *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

Here, for example, claim 1 recites that the thin film material is adapted to completely surround the periphery of the workpiece, the workpiece being a food packaging as recited in the preamble of the claim and upon which the invention is intended to be applied (the workpiece not itself being part of the claimed invention). This recitation is believed to be definite in view of Section 112 because it requires structural attributes

sufficient for completely surrounding the periphery of the food packaging, which should be readily comprehensible to one of skill in the art, particularly in view of the specification and the drawings as originally filed (see, for example, page 11, lines 8-10 of the specification).

It is further respectfully noted that the undersigned was unable to locate any citing of *In re Hutchinson*, 69 USPQ 138 in the current edition of the MPEP.

It is therefore respectfully submitted that the claims, as presented, are definite in view of Section 112. Accordingly, withdrawal of the rejections under 35 USC 112, second paragraph is respectfully requested.

The Substantive Issues - Sections 102 and 103

The Official Action rejected claims 13-15 and 24-26 under 35 USC 102(b) as being anticipated by WEDER (US Publication 2004/0237399; "WEDER").

The Official Action rejected claim 16 under 35 USC 103(a) as being unpatentable over WEDER.

In response, it is firstly noted that claim 13 has been amended, as indicated above. It is respectfully submitted that WEDER fails to teach a decorative band as recited by claim 13 as amended.

For example, it is respectfully submitted that WEDER fails to teach a thin film material with at least one first portion, extending longitudinally, having a maximum width L1, and

at least one second portion contiguous to said first portion and extending longitudinally and having a minimum width L2, the minimum width L2 being between one third and two thirds of the maximum width L1, as recited by claim 1.

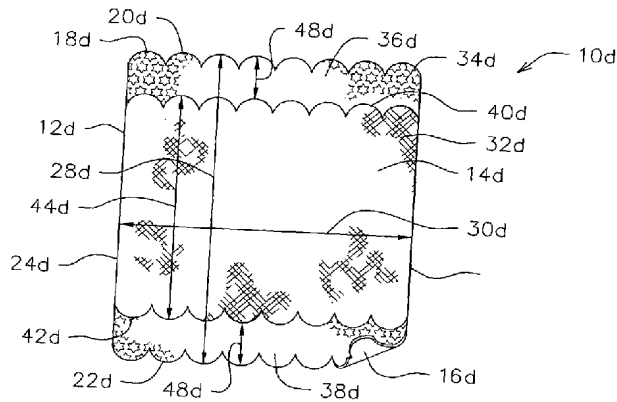
The Official Action offers Figure 7 of WEBER as disclosing a wrapper that is constructed of a sheet material with two opposite free ends 24d and 26d extending longitudinally from a first of the two free ends to a second of the two free ends to form a first longitudinal edge, 40d, and a second longitudinal edge. The Official Action contends that the sheet material has at least one first portion, having a maximum width L1 between 20d and 22d, and at least one second portion having a maximum width L2 between 42d and 40d, the minimum width L2 being between one third and two thirds of the maximum width L1.

The Official Action asserts that the third edge 24d and the fourth edge 26d (paragraph [0061]; the reference numeral 26d is missing on Figure 7) as being two opposite free ends. In the same manner, the Official Action considers that WEBER has a first longitudinal edge, supposed to be the first edge 20d (paragraph [0060] and not the first inner boundary 40d) and a second edge 22d, paragraph [0061].

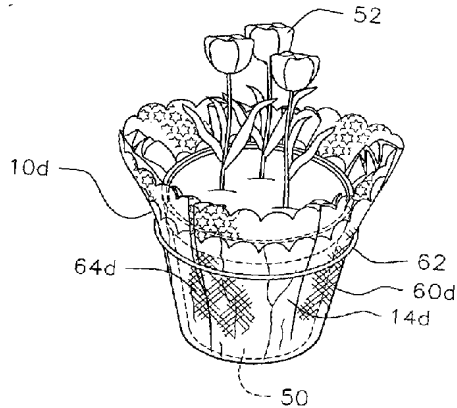
However, WEBER's sheet 10d is square. This square shape does not imply a longitudinal character of these edges.

Further, even assuming that WEBER discloses longitudinal edges, WEBER completely fails to disclose the

recitation of claim 13 relating the maximum width L1 and the minimum width L2.



**FIG. 7**



**FIG. 8**

Figures 7 and 8 of WEDER are provided above for the Examiner's convenience.

Again, the first length 28d between the edges 20d and 22d is offered as the claimed maximum width L1 of the first portion. However, the Official Action offers the width 44d (between 42d and 40d) of the central decorative portion 32d as the minimum width L2 of the second claimed portion.

The Applicant respectfully disagrees with the fact of considering a decorative portion of WEDER as the at least one second portion of the claim 13.

On the contrary, the central decorative portion 32d and the peripheral decoration 34d of WEDER merely corresponds to surface areas of different appearance, and do not correspond to different portion of the film material itself.

Moreover, it is irrelevant to consider the first length 28d as the width of any portion of the sheet 10d because the

peripheral portion 34d consists in a second portion 38d and a first portion 36d (see beginning of paragraph [0061], "peripheral decoration 34d comprising a first portion 36d and a second portion 38d," 36d and 38d being distinctive, non-connected areas on opposite sides of the wrapper).

Consequently, if the width 44d of the central portion 32d is considered as the claimed minimum width L2, the maximum width L1 of the first portion must therefore be the width 48d of the first peripheral portion 36d (or, alternatively, of the second peripheral decoration portion 38d).

As a consequence, the ratio  $L2/L1$  as taught by WEDER fails to satisfy the recitation "minimum width L2 being between one third and two thirds of the maximum width L1" as recited in claim 1. The Official Action offers paragraph [0063] as teaching the ratio  $L2/L1$  between one third and two thirds, but the width 46d, 48d and 44d disclosed in that same paragraph cannot be compared in any manner to the widths L1 and L2 of the first portion (see, e.g., elements 10 or 11 of Figures 1 and 2) and the second portion (see, e.g., elements 20 or 21 of Figures 1 and 2) recited in claim 13.

Further, careful reading of paragraph [0061] demonstrates that it is irrelevant to consider a first width between 20d and 22d and a second width between 40d and 42d. Claim 13, as amended, recites that the second portion is "contiguous to said first portion and extending longitudinally". That wording

should exclude portions that overlap or portions that are adjacent along their longitudinal edges.

Further, the Official Action (last paragraph of page 4) asserts that the first longitudinal edge, from the first to the second of the two free ends is rectilinear. However, at the second paragraph of page 4 of the Official Action, it is asserted that the opposite free ends are respectively the third side 24d and the fourth side 26d. Consequently the first longitudinal edge should be the first side 20d or the second side 22d (see paragraph [0060]). It is clear from the WEDER's Figure 7 that the sides 20d and 22d are not rectilinear but consist in a succession of half circles. Even the first and second inner boundary 40d and 42d are not rectilinear.

Moreover, it is further respectfully submitted that the wrapper disclosed by WEBER fails to teach or suggest a band, as recited by claim 13. On the contrary, WEDER's wrapper merely constitutes a sheet (Figure 7, element 10d) being approximately square, the first length 28d being a little bit longer than the second length 30d.

Thus, WEDER does not disclose a band, at least because a band implies an elongated shape, like a strip for which the opposite free ends are clearly identifiable and two longitudinal edges extend from one of said free ends to the other one. The definition of the noun "band" given by dictionary.com confirms that meaning.



**band**

**-noun**

**1.**

a thin, flat strip of some material for binding, confining, trimming, protecting, etc.: *a band on each bunch of watercress.*

**2.** a fillet, belt, or strap: *a band for the hair; a band for connecting pulleys.*

**3.** a stripe, as of color or decorative work.

**4.** a strip of paper or other material serving as a label: *a cigarband.*

band. Dictionary.com. Dictionary.com Unabridged. Random House, Inc. <http://dictionary.reference.com/browse/band> (accessed: October 23, 2010).

The claimed band is adapted to completely surround the periphery of a lateral annular wall. In WEDER, the sheet material 10d is a wrapper for wrapping a pot. That means it must cover most of the external surface of the pot including its bottom face and its lateral annular wall by folding the decorative sheet 10d. Therefore, WEDER relates to an object (a wrapper) which differs from the claimed subject matter (a decorative band).

Accordingly, based at least on the reasons set forth above, it is respectfully submitted that claim 13 is patentable over WEDER. It is further respectfully submitted that claims depending from claim 13 are patentable over claim 13 at least for depending from a patentable parent claim.

From the foregoing, it will be apparent that Applicant has fully responded to the June 24, 2010 Official Action and that the claims as presented are patentable. In view of this, Applicant respectfully requests reconsideration of the claims, as presented, and their early passage to issue. Rejoinder and allowance of the withdrawn claims is also respectfully requested,

at least for the reasons that the withdrawn claims all depend from a patentable parent claim.

In order to expedite the prosecution of this case, it is requested that the Examiner telephone the attorney for Applicant at the number set forth below if the Examiner is of the opinion that further discussion of this case would be helpful.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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